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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,189	11/20/2003	Tsutomu Okada	17272	9810
23389	7590	08/07/2007	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC			VRETTAKOS, PETER J	
400 GARDEN CITY PLAZA			ART UNIT	PAPER NUMBER
SUITE 300			3739	
GARDEN CITY, NY 11530			MAIL DATE	DELIVERY MODE
			08/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/718,189	OKADA, TSUTOMU
	Examiner Peter J. Vrettakos	Art Unit 3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 May 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 59-71 is/are pending in the application.
  - 4a) Of the above claim(s) 65-71 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 59-64 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

**The action is final. Bolded language below addresses most recent amendments.**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 59-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kittur et al. (5,846,241).

Kittur discloses a sheath/main body member (10), an elongated member (28), a tip end (see fig 8) (**the tip end is 30 in figure 1, which includes electrically insulating properties in addition to conductive piece 14**), insulating section (25 and 50), first electrode (24'), second electrode (34'), a central axis that runs longitudinal of the device, external portion (figure 8), and conductive wires (16, 20).

**Note: bipolar devices make obvious monopolar devices. There are numerous instances in the electrosurgical arts where bipolar and monopolar are disclosed together. The correlation is nearly as commonplace as on/off or black/white.**

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to optimize Kittur through, amongst other things, rearrangement of parts **motivation** provided in MPEP § 2144.05 II. A. referring to *In re Peterson*, 315

F.3d at 1330, 65 USPQ2d at 1382, "The normal desire of scientists or artisans to improve upon what is already generally known provides the **motivation** to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."

### ***Response to Arguments***

Applicant's arguments filed 2-9-07 have been fully considered but they are not persuasive. The Applicant argues that the asserted case law is inapplicable. However, this argument assumes that the applicability of case law found in the MPEP requires closely similar specific and often arcane facts in both the case law and the instant application. If the writers/assemblers of the MPEP were to believe that the facts of case law and the instant application (in order for application in a rejection) to be so similar, then the placement of the case law would be rendered impotent. In other words, if esoteric facts in the case law and application had to be near the same for use in a rejection, then the use of case law in the MPEP in prosecution would never be applicable. If that was the case, then why would the assemblers of the MPEP mention the case law at all? Instead, case law from the MPEP can be used to rely upon general themes in patent law (ex. motivation provided by normal desire for artisans to improve upon what is already known). To this end, the use of the case law above is deemed appropriate and is maintained.

Also note that element 30 (notwithstanding any definition in the patent – this asserted definition is still reasonable) which includes element 14 in Kittur figure 1

represents the tip end portion and is at least partially electrically insulating as now claimed in claim 59.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos  
August 1, 2007

  
ROY D. GIBSON  
PRIMARY EXAMINER

